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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/710,787	08/03/2004	Alexander Stoll	81101892 / FMC 1771 PUS	4786

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EXAMINER

ROSS, DANA

ART UNIT PAPER NUMBER

3722

DATE MAILED: 01/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/710,787	Applicant(s) STOLL ET AL.	
	Examiner Dana Ross	Art Unit 3722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 August 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 August 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8/3/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Examiner notes that there are four disclosed embodiments in Applicant's disclosure. Due to the generic nature of the current claim language, there does not appear to be a need for a species restriction at this time. However, it is noted that a restriction may be required with amended or new claims in the next office action.

Double Patenting

2. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

3. Claims 1-20 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-20 of copending Application No. 11/162545. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 12 and 18 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 12 and 18, it is not clear how the “second diameter is configured to flex”. It is not clear what is being claimed.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 2, 4-9, 11-13 and 16-18, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat. No. 4,640,652 (Rivera, Jr., hereafter ‘652).

‘654 teaches a tool holder for coolant deliver with a plurality of bores and a bottom surface, a conduit with first and second diameters and internal fluid passage (see figure 3 below) and spring 34 (see figure 2); the connection tube with a section with a smaller outside diameter than another section of the tube (see figure 3 below) with the inside of the tube engaging with the

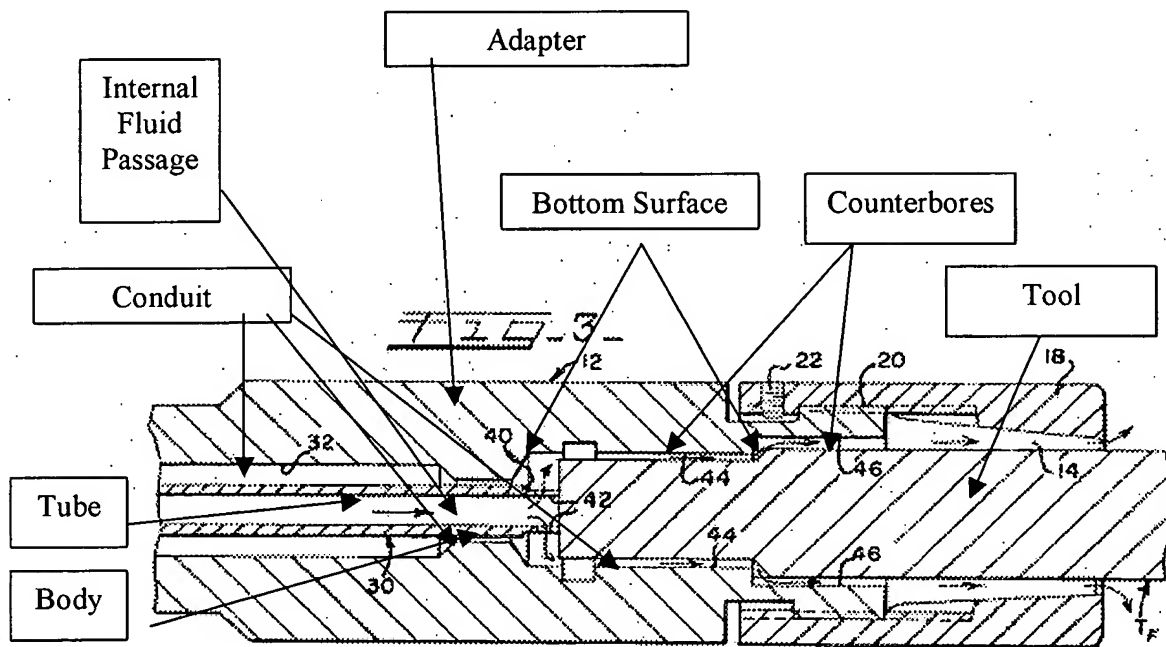
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internal fluid passage. It is noted that '652 teaches a chamfer on a flange portion (see figure 1, for example).

Regarding the spring, '652 teaches spring 34 meets which the limitation requirements of claims 5 and 8 in that the tool receiving portion the end portion (see area 26 of figure 2) which places the spring 34 between the "tool receiving portion" and the "bottom surface" (see figures 2 and 3).

Regarding the seal, '652 teaches a sealing between the "tool receiving portion" and the "end portion" (see col. 4, lines 63-68, for example).

Regarding the chamfer, '652 teaches a chamfered area of the internal fluid passage (see figure 2 near reference number 36).



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8. Claims 1, 2, 4-9, 11-13 and 16-18, as best understood, are rejected under 35

U.S.C. 102(b) as being anticipated by US Pat. No. 4,591,300 (Weiblen et al., hereafter '300).

'300 teaches a tool holder with a counter bore 25 adapted to receive a cutting tool and has a bottom surface (see figure 1, for example); a conduit axially aligned with the counter bore (see area near reference number 23 of figure 1); a locating member (see area of reference number 15 or 26 of figure 1) with a body portion at least partially disposed in the conduit; a flange portion disposed in the counter bore adjacent to the body portion (see figure 1 near reference number 26); internal fluid passage (see reference number 9 of figure 1) defined by the body and the flange portions; spring 28 which biases the locating member (see figure 1).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 3, 10, 14 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over both '652 and '300 in view of US Pat. No. 6,488,450 (Norris, hereafter '450).

'652 and '300 teaches all aspects of independent claims 1, 7 and 16.

'300 teaches a generic tool with one fluid passage (see figure 1, for example).

The use of tools with a plurality of fluid passages is well known in the art as is taught by '450 (see figure 1 and 2, for example).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the tool assembly as taught by '652 or '300 to include the tool head with a

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plurality of fluid passages as taught by '450 for the purpose of providing a plurality of lubricant to the cutting site and provide a flushing for chip removal for increased precision in the machining process. Applicant is also referred to US Pat. No. 6,056,486 (Colvin) for additional evidence of the well known feature of a plurality of lubricant passages in tools.

Allowable Subject Matter

11. Claims 15 and 20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The prior art neither anticipates nor renders obvious a tool holder assembly as claimed with the combination of limitations of claims 9, 14, 15 or claim 16, 19 and 20, specifically wherein the combination of limitations include the plurality of branch passages with a chamber with a tapered surface as claimed.

The closest prior art is '652 and '300 as is discussed in detail in the above rejections. Neither '652 or '300 teach the combination of limitations as claimed. Therefore neither '652 nor '300 anticipate the claimed inventions.

Furthermore, there is no prior art found that would render obvious the claimed inventions, and no motivation found to modify the prior art to obtain the claimed inventions.

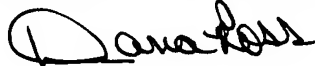
Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dana Ross whose telephone number is 571-272-4480. The examiner can normally be reached on Mon-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer Ashley can be reached on 571-272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Dana Ross
Examiner
Art Unit 3722



dmr